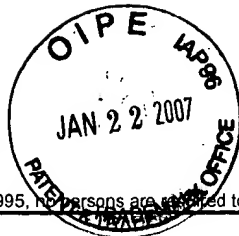


Doc Code: AP.PRE.REQ



PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

BER06209P00012US

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on **January 15, 2007**

Signature

Typed or printed
name**Corinne Byk**

Application Number

09/977,502

Filed

October 15, 2001

First Named Inventor

Steven E. Berkheimer

Art Unit

2165

Examiner

Pardo, Thuy N.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒

attorney or agent of record.

Registration number **32,273**☐

attorney or agent acting under 37 CFR 1.34.

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January 15, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒*Total of **One** forms are submitted.

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Pre-Appeal Brief Request for Review
Serial No.: 09/977,502
Docket No.: BER06209P00012US

STATEMENT FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Claims 1-28 are pending in the application, are rejected, and are at issue. The claims are rejected as anticipated by Tian et al. U.S. Patent No. 5,671,353 (Tian) or as obvious over Tian in view of Ringness U.S. Patent No. 6,456,395 (Ringness).

The grounds of rejection in the final action are substantially identical to those in the previous action. Applicant has addressed the individual claims in detail in the Request for Reconsideration filed August 1, 2006. Those arguments are not repeated herein. Instead, this review is requested with respect to a clear error in the Examiner's rejection involving the Examiner's characterization of Tian.

The claims of the application relate generally to a process or system for archiving. Particularly, claims 1-9 specify a method of archiving an item. Claims 10-19 specify an object oriented archival system. Claims 20-28 specify a method of generating layers corresponding to color separations for a printing process including establishing an archive. Regarding the rejection of claims 1-9, the action states that Tian discloses a method of archiving an item, as claimed. Regarding the rejection of claims 10-19, the action simply references the basis for the rejection of claim 1, notwithstanding the fact that there are elements in claim 10 not present in claim 1. Regarding claims 20-28, the action again takes the position that Tian discloses establishing an archive and related steps.

The position that the disclosure of Tian is directed to archiving is factually incorrect and is in error.

As noted in the action, Tian discloses that the structure and method described therein reside "in" a PACS which comprises a Picture Archival and Communications System. However, the system and method of the invention of Tian does not comprise archiving. Instead, the system and method of the invention of Tian is related to communication of messages and validation of such messages. Said another way, the system and method of Tian resides in an archiving system, rather than being an archiving system.

A word search of Tian shows that the word “archive” appears only once, at col. 6, line 2. This relates to retrieving an image from an archive. It does not describe steps involved in archiving an item. The word “archival” was found three times in Tian. In each instance the word is used relative to the name of the PACS system. The lack of use of the word “archive”, in any form, in Tian is instructive of the fact that the system and method of Tian does not relate to the function of archiving.

With respect to the subject matter of the invention of Tian, the claims are similarly instructive. Method claims 1-9 specify a method of validating a DICOM message. The word archive does not appear in these claims. Similarly, apparatus claims 10-20 relate to an apparatus for validating a DICOM message. The word archive does not appear. This is because Tian relates to communication functions in a PACS, rather than archiving in a PACS. The steps and structure in these claims all relate to communication of messages and particularly the validation of the messages for communication.

Throughout the Abstract, Summary and Detailed Description, Tian at most states that the object oriented structure or program resides in a PACS. As noted at col. 4, lines 44-47:

“The PACS typically comprises a plurality of computers, computer memories, memory storage disks, read only memories, random access memories, and workstations for viewing and interaction with digital medical imagery.”

As such, it is clear that the invention taught in Tian is not a PACS, but rather resides in a PACS. Further, Tian discloses no other type of archive with which the invention taught therein is in any way associated.

As noted above, the single reference to the word “archive” is in the following passage at col. 5, lines 66 through col. 6, line 4:

“The present invention also semantically validates DICOM messages regarding query and retrieval of medical imagery. For example, when

processing a query request to retrieve an image from an archive on computer memory disk storage, the present invention generates warnings regarding the semantic propriety of the query and retrieval request.”

From this description, it is clear that the invention in Tian semantically validates messages regarding query and retrieval of medical imagery. The query and retrieval of medical imagery is not the function of archiving, i.e., the placement of something, such as a document, record or material, in an organized collection. It is further noted that invention taught in Tian merely processes query and requests to retrieve an image and that the image itself is not on or within the system taught in Tian.

Tian discloses, with notable detail, methods for validating components of and variations of DICOM messages. Tian provides no disclosure for the function of archiving. The DICOM standard pertains to the field of medical informatics. Within that field, the standard addresses the exchange of digital information between medical imaging equipment and other systems. Thus, DICOM (Digital Imaging and Communications In Medicine) provides a standard for the exchange of digital information between medical imaging equipment and other systems such as PACS (Picture Archival and Communications System). From the proper titles of DICOM and PACS, one sees that both DICOM and PACS share the term “communications” and from the definition of a DICOM message pertains to the exchange between medical imaging equipment and other systems. In other words, DICOM and PACS and DICOM messages, which Tian teaches a method and apparatus for validating, all pertain to the function of communication. Clearly it is the communication function of a PACS on/in which the invention taught in Tian resides/exists, and that the invention taught in Tian facilitates, and not the archiving function of a PACS.

In further support of the position that Tian discloses a method of archiving, the Examiner references Figs. 2-14. A review of the description of Figs. 2-14, in cols. 3 and 4, does

not support Tian relating to an archive. Other than reference to a PACS, the word archive is not used. Instead, the description of Figs. 2-14, all state that the particular figure “illustrates a scenario in which . . . the present invention semantically validates . . .”. Thus, as with the claims and the technical description, the brief description of the drawings does not support that any of the figures illustrate any archiving function.

In view of the above, it is readily apparent that it is clear error for the Examiner to conclude that Tian is directed to a method of archiving. As such, claim 1 and its dependent claims 2-9 are not anticipated by Tian. Likewise, as it is not directed to archiving, any obviousness rejection is improper.

Similarly, Tian does not anticipate or render obvious any of independent claim 10 or its dependent claims 11-19. Moreover, independent claim 10 specifies that the archive “exhibits minimal redundancy with at least some elements linked to pluralities of the element and wherein some of the instructions, in response to a selected editing command, alter at least one element common to and linked to a selected plurality of other elements to thereby effect a one-two-many editing process . . .”. Such elements are not described in claim 1. Yet the rejection does not address these elements but merely reference the discussion of claims 1-7 which are inapplicable. The rejection of claim 10 is clearly in error for this reason as well.

With respect to claims 20-28, applicant references the previously filed Request for Reconsideration noting that Tian is not directed to establishing an archive and that the combination is improper. Combining the teachings of Ringness which relates to a method of separating colors, with Tian, which relates to semantically validating a message, would serve no purpose. Separating colors has nothing to do with validating a message.

In short, the basic premise of the rejections, that Tian discloses a method of archiving, is factually in error. Tian is directed to a method of validating a message for communication. Thus, the clear errors in the Examiner’s rejection are apparent and the action should be withdrawn.